

REMARKS

The drawings have been objected to because of informalities. The specification has been objected to because of informalities. The claims have been objected to because of informalities. Claims 14, 49 – 51, and 91 – 102 have been rejected under 35 USC 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. Claims 81, 83 – 90, and 103 -105 have been rejected under 35 USC 101 because they are directed to non-statutory subject matter. Claims 53, 56 – 57, 59, 61 – 65, 69 – 70, 72 – 79, 81, 83 – 93, and 96 – 97 have been rejected under 35 USC 102 (a) and (e) as being anticipated by Kramer (United States Patent No. 6,327,574). Claims 1 – 2, 5 – 17, 22 – 25, 27 – 28, 30 – 34, 41 – 52, 66 – 68, 71, 80, 95, and 98 – 101 have been rejected under 35 USC 103(a) as being unpatentable over Kramer (United States Patent No. 6,327,574). Claims 18 – 21 and 35 – 40 have been rejected under 35 USC 103(a) as being unpatentable over Kramer (United States Patent No. 6,327,574) in view of Dasan (United States Patent No. 5,761,662). Claim 29 has been rejected under 35 USC 103(a) as being unpatentable over Kramer (United States Patent No. 6,327,574) in view of Agrawal (“On Integrating Catalogs”). Claim 3 – 4, 54 – 55, 58, 60, 82, and 102 – 105 have been rejected under 35 USC 103(a) as being unpatentable over Kramer (United States Patent No. 6,327,574) in view of Fingerhut (United States Patent No. 6,493,327). Claims 26 and 94 have been rejected under 35 USC 103(a) as being unpatentable over Kramer (United States Patent No. 6,327,574) in view of Filfield (United States Patent No. 6,869,018). Applicant respectfully traverses these rejections and/or deems them

overcome for at least the following reasons. Reconsideration of this application is thus respectfully requested.

Objection to the drawings

The drawings have been objected to because of informalities. Applicant respectfully deems this objection overcome for at least the following reasons.

The present Office Action enumerates several reference numerals that are not recited in the specification and several spaces that render the drawings awkward. Applicant has submitted herewith Amended Drawings 1, 3, 4 and 5 in order to correct these informalities. Applicant respectfully submits that these amended figures overcome the objections presented herein.

Objection to the specification

The specification has been objected to because of informalities. Applicant respectfully traverses these rejections and/or deems them overcome for at least the following reasons.

Applicant has herein amended the title from "SYSTEM AND METHOD FOR AN ADAPTIVE USER COMMUNICATIONS DEVICE" to read "SYSTEM AND METHOD FOR ADAPTING AND PROVIDING CONTENT TO A USER OF A COMMUNICATIONS DEVICE.

Objection to the claims

The claims have been objected to because of informalities. Applicant respectfully deems these rejections overcome for at least the following reasons.

The present Office Action objects to claim 22 use of “relational database” requesting the term to be rewritten as “relational databases.” The present Office Action further enumerates claim 74 as having a redundant recitation of “in the virtual database.” Applicant respectfully submits that the currently amended claims 22 and 74 overcome the present objections.

Rejections based on 35 USC 112, second paragraph

Claims 14, 49 – 51, and 91 – 102 have been rejected under 35 USC 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. § 112, second paragraph, sets forth “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”

The present Office Action has rejected claim 14 as having an insufficient basis for “at least one user profile.” Claim 49 has been rejected because of the insufficient

basis for “said vendor data access.” Claims 50 – 51 have been rejected because of their dependency on claim 49. Claim 91 has been rejected because of an insufficient basis for “the communications devices.” Claims 92 – 102 have been rejected because of their dependency on claim 91. Applicant has amended Claims 14 and 49 to correct these issues.

Applicant respectfully submits that claim 91 recites “at least one user of a communications device” in the preamble and then subsequently recites “a plurality of device interfaces to at least one of the communications devices” a later element. Applicant respectfully submits that “the communications devices” and the “at least one user of a communications device” are not referring to the same thing. Applicant respectfully submits that the recitation of “a plurality of device interfaces to at least one of the communications devices” traverses the 112 rejection without amendment. Applicant respectfully submits that the present amendments traverse and overcome the 112 rejections.

Rejections based on 35 USC 101

Claims 81, 83 – 90, and 103 -105 have been rejected under 35 USC 101 “because they are directed to non-statutory subject matter.” Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. § 101 sets forth “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful

improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” Further, if any invention is not a process, machine, manufacture, or composition of matter or an improvement thereof, it is unpatentable as being directed to non-statutory subject matter.

The present office action rejects Claim 81 and the dependent claims 83 – 90 under 35 U.S.C. § 101, as software per se. Applicant respectfully submits that the claim 81 recites a means for modeling, searching and providing the output therefrom to a communications device. Applicant respectfully submits in conjunction with the specification generally, this claim element produces a useful, concrete, tangible result. Such a tangible result meets the requirement of 35 U.S.C. § 101. See, *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368 (Fed. Cir. 1998).

Further, Applicant asserts that this claim 81 requires more than mere mental steps and that claim 81 requires machine implementation of at least these steps. As such Applicant asserts that amended Claim 81 represents more than mere mental steps. See, *In re Meyer*, 215 USPQ 193 (CCPA 1982).

Applicant asserts that the 35 U.S.C. § 101 rejection of Claim 81 has been overcome for at least the foregoing reasons. Similarly, Applicant asserts the § 101 rejection of Claims 83 - 90 has been overcome, at least traversed because of these claims ultimate dependence from Claim 81.

Similarly, claim 103 recites displaying filtered content to a user on a wireless communications device. Applicant respectfully submits that for the reasons enumerated with respect to claim 81, claim 103 is similarly directed to patentable subject matter at

least because claim 103 recites “wherein the filtered available content is displayed to the user on the wireless communications device.”

Applicant asserts that the 35 U.S.C. § 101 rejection of Claim 103 has been overcome for at least the foregoing reasons. Similarly, Applicant asserts the § 101 rejection of Claims 104 - 105 has been overcome, at least traversed because of these claims ultimate dependence from Claim 103.

Rejections based on 35 USC 102(a) and (e)

Claims 53, 56 – 57, 59, 61 – 65, 69 – 70, 72 – 79, 81, 83 – 93, and 96 – 97 have been rejected under 35 USC 102 (a) and (e) as being anticipated by Kramer (United States Patent No. 6,327,574). Applicant respectfully traverses these rejections and deems them overcome for at least the following reasons.

35 U.S.C. 102(a) recites:

A person shall be entitled to a patent unless – (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent .

35 U.S.C. 102(e) recites:

A person shall be entitled to a patent unless – (e) the invention was described in-

(1) an application for patent, published under § 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in § 351(a) shall have the effect under this subsection of a national application published

under § 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in § 351(a).

Consistently, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See, M.P.E.P. §2131 citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant respectfully submits that the use of Kramer as a 35 USC 102(e) reference is misplaced. Further, for at the reasons associated with 35 USC 102(a), Kramer as a 102 reference is asserted to be overcome and effectively traversed.

Applicant respectfully submits that claims 53, 59, 81 and 91 each recite a searcher that communicates the at least one targeted message of interest to said communications device for provision to the user. In referencing Kramer the current office action recites Column 23, line 5 as teaching this searching to provide content. Applicant respectfully submits that Kramer actually teaches providing illumination lists ordered by score of the list match to consumers' transactions. See Column 23, line 5 - 15. Applicant further submits that the searcher of Kramer, to the extent such exists, does not communicate with any device whatsoever, nor does the present action contemplate or cite that Kramer does so. Applicant respectfully submits that the providing of lists and scores is not providing content as the content is the underlying

information associated with the scores. In this regard, Kramer teaches that the "goal of creating the attribute vector is to allow illumination candidates to be evaluated and ranked according to their relevance to the consumer." Kramer @ Column 21, line 32. Further, Kramer teaches "the merchant identified in each statement line may be responsible for transmitting a number of illuminations to be applied only to its one line." Kramer @ Col. 21, line 45. Contrarily, the present invention is directed to a system designed for providing content in accordance with the database to a user via a communications device. There is no merchant designation that allows a designated party to provide information within a certain portion of the display. The display and content are selected via a searcher that provides content to said at least one of said at least one communications device over the at least one network, in accordance with said virtual database. To the extent that Kramer discloses a searcher, which applicant respectfully submits it does not, that searcher does not operate to provide content over the network in accordance with the database.

Independent claims 59, 81 and 91 recite a similar searcher as that recited in claim 53. No piece of art is recited to remedy this deficiency in the teaching of Kramer as applied to the present application.

As such, Applicant respectfully submits Claims 53, 59, 81 and 91 are patentably distinguishable over Kramer, at least for the foregoing reasons. Applicant further submits that each of Claims 54 – 57, 60 – 80, 82 - 90 and 92 - 102 is similarly distinguishable over the prior art of record, at least by virtue of each Claim's ultimate dependence from patentably distinct base Claim 53, 59, 81 and 91.

Rejections based on 35 USC 103(a)

Claims 1 – 2, 5 – 17, 22 – 25, 27 – 28, 30 – 34, 41 – 52, 66 – 68, 71, 80, 95, and 98 – 101 have been rejected under 35 USC 103(a) as being unpatentable over Kramer (United States Patent No. 6,327,574). Claims 18 – 21 and 35 – 40 have been rejected under 35 USC 103(a) as being unpatentable over Kramer (United States Patent No. 6,327,574) in view of Dasan (United States Patent No. 5,761,662). Claim 29 has been rejected under 35 USC 103(a) as being unpatentable over Kramer (United States Patent No. 6,327,574) in view of Agrawal (“On Integrating Catalogs”). Claim 3 – 4, 54 – 55, 58, 60, 82, and 102 – 105 have been rejected under 35 USC 103(a) as being unpatentable over Kramer (United States Patent No. 6,327,574) in view of Fingerhut (United States Patent No. 6,493,327). Claims 26 and 94 have been rejected under 35 USC 103(a) as being unpatentable over Kramer (United States Patent No. 6,327,574) in view of Filfield (United States Patent No. 6,869,018). Applicant respectfully traverses these rejections and deems them overcome for at least the following reasons.

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *MPEP 706.02(j)*.

Claim 1 recites "a searcher that provides content to said at least one of said at least one communications device over the at least one network, in accordance with said virtual database." In referencing Kramer the current office action recites Column 23, line 5 as teaching this searching to provide content. Applicant respectfully submits that Kramer actually teaches providing illumination lists ordered by score of the list match to consumers' transactions. See Column 23, line 5 -15. Applicant respectfully submits that the providing of lists and scores is not providing content as the content is the underlying information associated with the scores. In this regard, Kramer teaches that the "goal of creating the attribute vector is to allow illumination candidates to be evaluated and ranked according to their relevance to the consumer." Kramer @ Column 21, line 32. Further, Kramer teaches "the merchant identified in each statement line may be responsible for transmitting a number of illuminations to be applied only to its one line." Kramer @ Col. 21, line 45. Contrarily, the present invention is directed to

a system designed for providing content in accordance with the database to a user via a communications device. There is no merchant designation that allows a designated party to provide information within a certain portion of the display. The display and content are selected via a searcher that provides content to said at least one of said at least one communications device over the at least one network, in accordance with said virtual database. To the extent that Kramer discloses a searcher, which applicant respectfully submits it does not, that searcher does not operate to provide content over the network in accordance with the database.

Independent claims 58 and 103 recite a similar searcher as that recited in claim 1. This deficiency in the teaching of Kramer as applied to the present application is not overcome, nor is it asserted to be, by either Fingerhut, Agrawal, or Filfield.

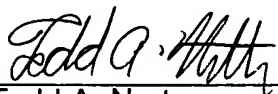
As such, Applicant respectfully submits Claims 1, 58 and 103 are patentably distinguishable over Kramer in view of the admitted prior art, at least for the foregoing reasons. Applicant further submits that each of Claims 2 – 52, and 104 - 105 is similarly distinguishable over the prior art of record, at least by virtue of each Claim's ultimate dependence from patentably distinct base Claim 1, 58 and 103.

CONCLUSION

In summation, Applicant respectfully submits that all of the claims presently appearing in this application are in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or other matters whose resolution

may be advanced by a telephone call, the Examiner is cordially invited to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Todd A. Norton", is positioned above a horizontal line.

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